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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,438	03/15/2004	Jonathan W. Burks	NLL101	8951
30245	7590	12/05/2005	EXAMINER	
ANTHONY EDW. J CAMPBELL PO BOX 160370 AUSTIN, TX 78716			COHEN, LEE S	
			ART UNIT	PAPER NUMBER
			3739	
DATE MAILED: 12/05/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/800,438

Applicant(s)

BURKS, JONATHAN W.

Examiner

Lee S. Cohen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/15/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14, 19, and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claims include plural insertion holes with lead insertions through the holes (e.g., Figure 2 embodiment). The claims also require plural wires and lead connectors as shown in Figure 5 (elements 24, 26, 28). These embodiments appear to be mutually exclusive and not capable of use together.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3, 6-14, and 16-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2 and 3 set forth an improper Markush recitation since "or" is used in lieu of --and--. Claims 6-14 and 16-19 are vague since the preambles of these claims only relate to an element of the electrode assembly in lieu of the entire assembly.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 9, 11, and 13 are rejected under 35 U.S.C. 102(b) as being clearly by Minogue (6,134,480). The disclosed assembly includes body 13 with lead attachments 18,19 inserted through holes in the body. The bottom surface includes an electrically conductive adhesive. The attachments can be metal-coated plastic (col. 3, line 9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 5, 8, 15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minogue (6,134,480) in view of Keusch et al (4,777,954). Minogue fails to disclose the particular material for the body and the use of a peel-off backing. Keusch et al disclose such features to be conventional in the art at column 19, lines 45-55. Accordingly, the use of these features in Minogue would have been obvious to the skilled artisan since they relate only to design expedients.

Claims 6, 7, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minogue (6,134,480) in view of Schaefer et al (5,255,677). Minogue fails to disclose an isolation perforation or slit in the body as well as the particular shapes. Schaefer et al disclose such features (elements 42 and 56) to be well known in the art. Accordingly, the use of a perforation or slit in Minogue would have been obvious to the skilled artisan to permit separation of

electrodes if the practitioner so desires. Further, the use of a rectangle or double square shape would also have been mere design expedients since varying shapes are disclosed by Schaefer et al.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minogue (6,134,480) in view of Keusch et al (4,777,954) as set forth supra, and further in view of Schaefer et al (5,255,677). The use of a perforation or slit as shown by Schaefer et al has been detailed supra.

Claims 1-13 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schaefer et al (5,255,677) in view of Keusch et al (4,777,954). Schaefer et al disclose the basic electrode assembly (Figures 5 and 11) including an isolation perforation or slit in the body as well as varying shapes. Schaefer et al fail to disclose the use of insertion holes with lead attachments. Keusch et al disclose such features to be conventional in the art at column 19, lines 45-55. Accordingly, the use of these features in Minogue would have been obvious to the skilled artisan since they only relate to well known electrical attachments for electrodes to transmit signals. Further, the use of a rectangle or double square shape would also have been mere design expedients since varying shapes are disclosed by Schaefer et al.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The other cited art disclose electrode assemblies with perforations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee S. Cohen whose telephone number is 571-272-4763. The examiner can normally be reached on Monday-Friday, 7:00-3:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lee S. Cohen
Primary Examiner
Art Unit 3739

LSC
November 23, 2005